

**REMARKS**

Claims 1-11 are pending in this application of which claims 1, 7 and 10 are independent. Reconsideration in light of the foregoing amendments and the following remarks is respectfully solicited.

**Claim Amendments**

Claims 1-5 have been amended for improved cosmetics and clarity. Claim 1 has been further amended to recite that the receiver and the controller are formed on a first multilayer substrate and a second layer substrate, respectively. New claims 7 and 10 similarly recite this structure. Support for new claims 6-11 can be found in the specification at, e.g., page 10 (last paragraph) – page 12, and in Figs. 4-5.

**Indefiniteness Rejection**

The Examiner rejects claims 1-4 under 35 U.S.C. § 112, second paragraph, for purportedly being indefinite based on insufficient antecedent basis for the term “receiving section.” This term has been replaced with --receiver-- to correct antecedent basis. Withdrawal of the claim rejection is respectfully solicited.

**Obviousness Rejections**

The Examiner rejects the claims as follows:

(1) Claims 1, 2 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato (USPN 4,835,531) in view of Yamamoto (USPN 6,078,293) and further in view of Naim (USPN 6,694,200); and

(2) Claims 3-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Yamamoto and further in view of Japanese Patent Laid-Open no. 8-216735, which is cited in the background section of the specification.

These rejections are respectively traversed.

For the Examiner's convenience, a clean version of claim 1 is reproduced below.

1. A keyless entry system for a vehicle comprising:
  - a transmitter for transmitting a radio wave signal by operation of a user;
  - a receiver formed on a first multilayer substrate for receiving the signal from the transmitter via an antenna; and
  - a controller formed on a second multilayer substrate for controlling action as indicated by the signal,wherein at least one layer of the first multilayer substrate and at least one layer of the second multilayer substrate are electrically connected to a common ground.

Sato is relied upon for teaching a transmitter 1, receiver 8 and antenna 6, and controller

13. It is acknowledged, with which Applicant agrees, that Sato fails to disclose that a ground of the receiver and a ground of the controller are electrically connected. As such, Yamamoto is relied upon for this teaching. It is alleged that it would have been obvious combination to "allow the overall reduction in the number of components and cost."

It is noted that Naim is relied upon for teaching an element (receiving section is formed in a unit that is attachable and detachable with respect to the controlling section) not found in claim 1, rather in claim 2. It is believed that the Examiner should have rejected claim 1 over Sato in view of Yamamoto only. Nonetheless, Applicant will address Sato in view of Yamamoto and further in view of Naim, so as to completely respond to the Office Action.

Motivation alleged by the Examiner is deemed flawed. The Examiner is charged with the initial burden of providing the realistic requisite motivation for combining applied references to arrive at the claimed invention with a reasonable expectation of successfully achieving a specific benefit. *Smith Industries Medical System. v. Vital Signs*, 183 F.3d 137 (Fed. Cir. 1999). The

Examiner's assertion that the combination would result in overall reduction in the number of components and cost is not realistic and quite arbitrary.

Sato illustrates only a block diagram of an automobile remote control system. In Sato, assuming that a ground of the receiver 8 and controller 13 were electrically connected, as claim 1 requires, the Examiner has not made clear how this modification would reduce the number of components. As far as Applicant can tell, the number of components would remain the same. Furthermore, the Examiner has not made clear how this modification would reduce cost. Applicant questions what types of cost would be reduced by electrically connecting the ground of receiver 8 and controller 13. Hence, there is significant ambiguity in the statement of motivation.

In fact, it has been held that even if prior art could have been modified so as to result in the combination defined by the claims, the modification would not have been obvious unless the prior art suggested the desirability of the modification. *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986). The fact that a ground of the receiver and transmitter of Sato could be connected does not, as a matter of fact, make the combination obvious. The Examiner has to provide a realistic showing in the prior art of a suggestion of the desirability to modify. Any desirability to combine is not found in any of the cited references. The basis of the rejection is no more than inappropriate hindsight reconstruction using Applicants' claims as a guide. *In re Warner*, 379 F.2d 1011 (CCPA 1967). The Examiner has not met the initial burden of providing realistic requisite motivation, thus rendering the obviousness rejection improper.

Assuming that motivation could be found, the combination still fails to teach each and every element of claim 1. There is no disclosure in either Sato, Yamamoto or Naim (discussed further below) of a "a receiver formed on a first multilayer substrate ... and a controller formed

on a second multilayer substrate ..., wherein at least one layer of the first multilayer substrate and at least one layer of the second multilayer substrate are electrically connected to a common ground,” as claim 1 recites.

As regards Naim, this reference is directed to a hard disk portable device, and in no way is directed to the same field of endeavor of keyless entry systems. To overcome this presumption, the Examiner asserts that Naim is in the same field of endeavor of attachable and detachable devices. However, field of endeavor relates to the field in which the invention is directed, not individual elements, much like the USPTO classification system. In fact, Naim is non-analogous art, and is therefore not combinable with either Sato or Yamamoto. *See In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992) (A prior art reference is analogous if the reference is in the field of applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned.). The Examiner has not made clear how Naim could be reasonably pertinent to a particular problem. Applicant finds no relationship.

Claims 2-6 are patentable at least based on dependency to presumably allowable claim 1. Withdrawal of the rejections (both (1) and (2) listed above) is respectfully solicited.

As regards new claims 6-11, Sato, Yamamoto, Naim, ‘735 Patent, or any combination thereof fails to teach each and every elements of any of these claims.

For instance, claim 6, which depends from presumably allowable claim 1, recites “wherein at least one layer of the first multilayer substrate and at least one layer of the second multilayer substrate are electrically connected so as to exhibit a mirror effect for enhancing receiving sensitivity of an antenna connected to the receiver.” Claims 9 and 11 similarly recite

this limitation. Nowhere in any of the applied references, or in any combination thereof, is this limitation taught.

Moreover, claim 7 recites a receiver and controller combination comprising “a receiver formed on a first multilayer substrate; and a controller formed on a second multilayer substrate is electrically connected to the receiver, wherein the receiver and controller are connected to a common ground.” Claim 10 recites an antenna for a keyless entry system comprising “a first multilayer substrate on which the receiver is formed; a second multilayer substrate on which a controller is formed, wherein at least one layer of the first multilayer substrate and at least one layer of the second multilayer substrate are electrically connected to a common ground.” As described above, any combination of the references fails to disclose such types of structure.

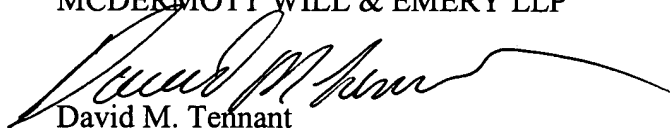
Even further, the combination of the references fail to teach “wherein at least one layer of the first multilayer substrate and at least one layer of the second multilayer substrate are electrically connected to the common ground,” as claim 8 recites.

If the Examiner has any comments or questions regarding this response or the application in general, the Examiner is encouraged to contact the undersigned in order to expedite prosecution of this case.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



David M. Tennant

Registration No. 48,362

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 DT:MWE  
Facsimile: (202) 756-8087  
**Date: June 17, 2004**